

RD0530-ASGCO

PATENT APPLICATION
Serial No. 09/808,657REMARKS

Claims 2-8, 10, 12-57 and 71-89 are pending in the captioned Application in which claims 2-8, 10, 12-21, 23-25 and 29-34 are allowed, in which previously finally rejected claims 22, 26-28 and 35-38 are to be allowed as indicated in the Advisory Action, and in which claims 58-70 are canceled hereby without prejudice. Claims 39-89 are withdrawn by the Examiner under a provisional restriction requirement and rejoinder is requested. Claims 1, 9 and 11 were previously canceled.

Claims 22 and 81 are amended to clarify the snap-on snap-off releasable engagement of the scraper blade and blade holder as recited, consistently with the agreement reached in the Telephone Interviews. Amended claims 81 and 86 recite a blade body for consistency.

Allowed claim 10 is amended hereby to correct a typographical error wherein the first four words of the claim were inadvertently stricken in the prior Amendment. The amendment to claim 10 is not made for purposes of patentability, but is made to correct a typographical error, notwithstanding the patentability of the original claim.

This amendment does not narrow the scope of any claim element and so is not limiting of any claim element and Applicant reserves the right to assert the doctrine of equivalents with respect to such element.

Reconsideration of Restriction Requirement:

Applicant hereby requests reconsideration of the Restriction Requirement in view of the response herein, and rejoinder and allowance of claims 39-57 and 71-89 in accordance with the Telephone Interview. Withdrawn claims 58-70 are canceled without prejudice.

In view of the patentability of generic independent claims 2, 3, 12, 18, 22, 23, 29 and 34, the provisional restriction regarding at least claims 39-48, 49-57, 71-80 and 81-89 should be withdrawn because those claims recite elements and combinations thereof that are similar to certain elements and features recited in one or more of the allowed claims.

In addition, it is noted that claims 71-89, of which at least claims 71 and 81 are generic, are directed to a belt scraper as are allowed claims 2-8, 10, 12-21, 23-25 and 29-34,

RD0530-ASGCO

PATENT APPLICATION
Serial No. 09/808,657

and so are properly within elected Group I and should be reinstated and allowed for at least the reasons set forth in the prior response regarding claims 2-8, 10, 12-21, 23-25 and 29-34.

In addition, Applicants' previous responses provided reasons overcoming the rebuttable presumption accorded the Examiner for making a *prima facie* explanation in an *initial* restriction requirement. MPEP §803. "It still remains important ... that no requirements be made which might result in the issuance of two patents to the same invention." MPEP §803.01.

Thus, all of claims 2-8, 10, 12-38, 39-48, 49-57 and 71-89 are patentable and should be allowed in the present application.

Rejection Under 35 U.S.C. §102(b):

The rejection of allowed claims 1, 8-11, 19 and 21 under 35 U.S.C. §102(b) as being anticipated by US 4,925,434 to Swinderman et al set forth in the Final Office Action mailed November 4, 2003 is in error as confirmed by Examiner Sharma in the Telephone Interview. As set forth in the Interview, the rejection is withdrawn and claims 1, 8-11, 19 and 21 are allowed.

Rejections Under 35 U.S.C. §103(a):

The rejection of claims 2, 6, 7, 20, 22, 26-28 and 35-38 under 35 U.S.C. §103(a) as being unpatentable over Swinderman et al in view of US 4, 838,409 to Rappen as set forth in the Final Office Action mailed November 4, 2003 is partly in error, as follows:

The rejection of allowed claims 2, 6, 7 and 20 is in error as confirmed by Examiner Sharma in the Telephone Interview. As set forth in the Interview, the rejection is withdrawn as to these claims which are allowed.

As to claims 22, 26-28 and 35-38, the rejection is traversed in view of the clarifying amendment to claim 22.

Swinderman et al relates to a torsional tensioning device 10 for imparting torsional bias to shaft 15 for urging scraping blades 14 against a conveyor belt 16. Shaft 15 is tensioned by first and second hubs 48 and 64 and the elastomeric torsion sleeve 58

RD0530-ASGCO

PATENT APPLICATION
Serial No. 09/808,657

therebetween, and hub 48 is selectively connectable to shaft 15 and hub 64 is lockable to a stationary frame member. (Abstract; column 4, lines 13-45). Scraper blades 14 are removably secured to shaft 15 and engage conveyor belt 16. (Column 2, lines 37-41). As is visible in Figure 1 thereof, plural blades 14 appear to be mounted on arms extending from shaft 15. It is noted that Swinderman et al is directed to a torsional tensioner 10 for biasing a shaft 15 and does not describe or suggest either other tensioning arrangements or other blade mounting arrangements.

Rappen relates to a scraper device for conveyor belts wherein a blade holder 5 having sprung arms (i.e. resilient or springy arms 7, 8) can be mounted to engage a bearing axle 2. Blade holder 5 carries scraper blades 6 at the end of the spring arms 7, 8 remote from the axle 2 to press blade 6 against a conveyor belt 1. (See Figure 1; Abstract; column 4, lines 38-57).

The purported combination of Swinderman et al and Rappen is improper under the law because neither reference suggests its combination with the other. Absent some statement or suggestion within the references themselves that they should be combined, there is no nexus which could substantiate the suggested combination.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so."

ACS Hospital Systems, Inc. vs. Montefiore Hospital, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities between the reference(s) and the claimed invention. *Rulz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 U.S.P.Q.2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 U.S.P.Q.2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the

RD0530-ASGCO

PATENT APPLICATION
Serial No. 09/808,657

manner claimed."

Ecolochem Inc. v. Southern California Edison, 56 U.S.P.Q.2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffet*, 149 Fed.3d 1350, 1357 (Fed. Cir. 1998), 47 U.S.P.Q.2d 1453, 1456.

In addition, even if such combination could be made, it is submitted that the resulting structure would not be that of the claimed invention, but would just be the torsional tensioning arrangement 10 of Swinderman et al with the blade holder 5 and blade 6 of Rappen mounted on shaft 15 of Swinderman et al.

The Examiner admits that Swinderman et al "fails to disclose a blade body having a plurality of pairs of parallel skirts defining a blade cavity, while the blade holder is disposed in the blade cavity with the skirts releasable engaging the blade holder...." In fact, Swinderman et al does not suggest any substantially parallel skirts extending from a blade body for releasable engaging a blade holder.

Rappen does not disclose what Swinderman et al lacks. Rappen clearly differentiates between a blade holder 5 having resilient arms 7, 8 and a blade 6 that is secured to blade holder 5, such as by inserts or attach grooves and springs. That the blades 6 may easily be exchanged strongly confirms that Rappen clearly separate blade 6 from blade holder 5. (Column 3, lines 28-55). The Examiner's assertion that Rappen discloses "a blade body having a pair of skirts defining a blade cavity while the blade holder is disposed in the blade cavity" is not supported by the Rappen reference, but is impermissible hindsight based upon the teaching of Applicant's invention.

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

Uniroyal Inc. vs. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". *W. L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 U.S.P.Q. 303, 312, 313 (Fed. Cir. 1988).

RD0530-ASGCO

PATENT APPLICATION
Serial No. 09/808,657

Accordingly, Applicants' claim 22 is patentable because it recites"

"a blade holder;

"a scraper blade having a blade body, a blade tip on one end of said blade body and a pair of skirts extending from an end of said blade body opposite the blade tip, wherein said pair of skirts are flexible and define a blade cavity for receiving and engaging said blade holder, and wherein said pair of skirts flex so that said scraper blade snaps into and out of engagement with said blade holder;

"wherein said scraper blade is mounted on said blade holder with said blade holder disposed in said blade cavity with said skirts releasably engaging said blade holder,"

which is not described or suggested by Swinderman et al and/or Rappen, whether taken individually or properly combined.

Applicant's claims 26-28 and 35-38 are patentable at least because they depend from patentable claim 22.

Accordingly, the rejection under 35 U.S.C. §103(a) is overcome and should be withdrawn.

Formal Drawing:

Examiner Sharma confirmed in the Telephone Interview that the drawing submitted by Applicants had been accepted.

Conclusion:

Applicant respectfully requests that the objections and rejections, and the provisional restriction be withdrawn, and that the captioned Application including claims 2-8, 10, 12-57 and 71-89 be allowed and passed to issuance.

Please charge the \$385.00 fee for requesting continued examination and the \$55.00 fee for filing a response within the first month after the mailing of the Advisory Action to Deposit Account 04-1406 of Dann, Dorfman, Herrell & Skillman.

A Fee Transmittal is submitted herewith.

The number of claims remaining being less than the number previously paid for, no fee is due therefor in consequence of this timely filed response.

Should any other or additional fee be due in consequence of this response, please

RD0530-ASGCO

PATENT APPLICATION
Serial No. 09/808,657

charge such fee and deposit any refund to Deposit Account 04-1406 of Dann, Dorfman,
Herrell & Skillman.

The Examiner is requested to telephone the undersigned attorney if there is any
question or if prosecution of this Application could be furthered by telephone.

Respectfully submitted,
Dann, Dorfman, Herrell & Skillman, P.C.
Attorneys for Applicant(s)

By: 

Clement A. Berard

PTO Registration No. 29,613

April 27, 2004

Dann, Dorfman, Herrell and Skillman, P.C.
1601 Market Street, Suite 2400
Philadelphia, PA 19103

Telephone: 215-563-4100
Facsimile: 215-563-4044